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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,570	08/06/99	TONCELLI M	DRAGO-P86-RE

IM22/1216

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EXAMINER	
AFTERGUT, J	
ART UNIT	**PAPER NUMBER**
1733	2

DATE MAILED: 12/16/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/369,570	Applicant(s) Toncelli
	Examiner Jeff H. Aftergut	Group Art Unit 1733

☐ Responsive to communication(s) filed on _____ .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *three* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-38* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-38* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☒ received in Application No. (Series Code/Serial Number) *08/513,687* .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Reissue Applications

1. Claims 21-38 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp.* v. *United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

> The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.

In the patented file, as evidenced by the reasons for allowance as well as applicant's arguments in the amendment dated 12-23-96, the limitations relating to rear substantially smooth face of the stone which was free from grooves as well as the limitation relating to the disposing of a reinforcing layer between the linear reinforcing elements and the rear face of the stone material were limitations which applicant expressly added to define of the prior art of record. Note that in the response dated 12-23-96, the applicant expressed the same and the same was expressed in the reasons for allowance dated 2-19-97. The omission of this language from the claim in the reissue clearly relates to subject matter previously surrendered by applicant (note that there was counter statement or comment submitted by applicant in relation to the examiner's reason for allowance in the file history of the parent file and thus the subject matter omitted in the claims herein was subject matter previously surrendered by applicant).

2. This reissue application was filed without the required offer to surrender the original patent or, if the original is lost or inaccessible, an affidavit or declaration to that effect. The

original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

3. This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.

A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 255,795 in view of Japanese Patent 3-247,852 optionally further taken with Japanese Patent 6-64076.

E.P. '795 taught that it was known at the time the invention was made to reinforce a stone slab with a linear glass fiber reinforcement which included glass fiber roving which was coated with a resin material. The reference failed to teach the specific amount of resin in the

reinforcement applied to the back of the stone slabs. Note that the reference taught that the slabs of stone were of a thickness of 5-7 mm. The ordinary artisan, however, would have readily understood what amount of reinforcement to resin ratio to use in the final stone panels as evidenced by Japanese Patent '852.

Japanese Patent '852 taught that it was known reinforce an artificial or natural stone panel with resin impregnated fibers wherein the ratio of reinforcement to resin lied in the range of 0.5-2.0. clearly, the same would have included half as much resin to the amount of reinforcement in the finished reinforcing layer. It certainly would have been within the purview of the ordinary artisan to provide a stone panel which was reinforced with a linear reinforcing member wherein the reinforcement included a resin therein in a percentage of twice as much reinforcing material to the amount of resin as suggested by Japanese Patent '852 in the process of making a stone panel as taught by E.P. '795.

While it is believed based upon the discussions contained within E.P. '795 that one skilled in the art would have applied the longitudinal, non-twisted reinforcement directly against the stone panel, to further evidence that those skilled in the art would have performed the same the reference to Japanese Patent '076 is cited. The reference made it clear that one skilled in the art would have applied the unidirectional fiber reinforcement against the back of the stone in order to adequately reinforce the same, see layer 102. In order to provide adequate reinforcement to a stone panel, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the techniques of E.P. '795 to provide a longitudinal, non-twisted

reinforcement against a stone panel as suggested by Japanese Patent '076 wherein the specific amount of resin remaining in the panel would have been determined through routine experimentation and would have included amounts as specified by applicant as evidenced by Japanese Patent '852.

6. Claims 1-20 and 26-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631,015 in view of Japanese Patent 6-64076, Japanese Patent 3-247852, and E.P. 255,795.

E.P. '015 taught the basic reinforced panel of stone material which included grooves therein into which a longitudinal reinforcing element was disposed. The reference taught the use of steel or glass reinforcing material for the reinforcement disposed within the grooves. The reference failed to teach the use of plural layers of reinforcement wherein the amount of resin in the reinforcing material would have been less than the amount of reinforcing material disposed therein and wherein the additional reinforcing layer was formed from longitudinally disposed filaments therein.

However, the use of multiple layers of reinforcement to reinforce a stone panel was known as evidenced by both Japanese Patent '076 and Japanese Patent '852. The incorporation of the specified amount of resin in the reinforcing materials was suggested by Japanese Patent '852 and the specific amounts would have been determined through routine experimentation. The applicant is advised that one skilled in the art would have appreciated that the reinforcement employed in the operation would have been continuous non-twisted roving as the same provided the best strengthening reinforcement in the finished composite panel as evidenced by E.P. '795. The

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applicant is referred to the various figures which reference the rovings when used as a reinforcement and that the same provided the finished panel with the greatest strength. Because it was known to employ multiple layers of reinforcement against the back of a stone panel to reinforce the same as evidenced by either one of Japanese Patent 6-64076 or Japanese Patent 3-247852 (note that Japanese Patent '852 evidenced that those skilled in the art would have utilized an amount of resin as specified by applicant) when forming a panel which included grooves and reinforcing material disposed therein as suggested by E.P. '015 and wherein the reinforcing material would have included plural layers of longitudinally extending non-twisted reinforcing materials as suggested by E.P. '795. The particular amount of resin selected as well as the type of reinforcing materials used was certainly known as evidenced by the prior art as set forth above and the selection of a specific type of reinforcement as well as a specific amount of resin would have been within the purview of the ordinary artisan.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.K. '438 taught the application of plural mats adjacent the back of a slab of marble, see mats 2, 5 and marble slab 1.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Aftergut whose telephone number is (703) 308-2069.

JHA
December 3, 1999

JEFF AFTERGUT
PRIMARY EXAMINER
ART UNIT 1733